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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,153	07/31/2001	James O. Schreckengast	10004047-1	3204

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EXAMINER

WALSH, JOHN B

ART UNIT PAPER NUMBER

2151

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/919,153	<b>Applicant(s)</b> SCHRECKENGAST ET AL.	
	<b>Examiner</b> John B. Walsh	<b>Art Unit</b> 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/31/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 recites an information utility, the language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. All of the elements and features of the claim can be implemented in software alone, thus it does not provide for tangible subject matter. Claim 19 recites a method. However, the language of the method claimed raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Also, the method does not produce a concrete result since if one of ordinary skill performed the method repeatable results would not occur. Furthermore, the method does not produce a tangible result since it does not require the use of any particular tangible hardware or structure.

The applicant amended the claims to include the term "computing system". However the addition of this term does not overcome the rejection because the term "computing system" is a

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broad term which does not limit the subject matter merely to a machine (see applicant's remarks p. 17) since a person's abstract idea could be construed as a computing system since a person can compute.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. As best understood, claims 1-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Amazon.com.

As concerns claim 1, a proprietary information utility comprising: an interface (a computer) that provides outside entities connection to the proprietary information utility; a repository (storage medium storing the webpages and data) that contains proprietary information, wherein the repository is compartmentalized by user identity and entitlement, so that a first category of proprietary information is within private domains (private data) available to only a single user and a second category of proprietary information is within domains to which multiple users (public data) may be granted use in response to acquiring a license to use particular proprietary information within the second category of proprietary information; application services (searching the webpages); a security system (secure webpages and data), that limits access of each user connecting to the proprietary information utility to proprietary information to which each user is entitled, the proprietary information to which each user is entitled being accessed through use of the application services; and, a billing system (billing

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system for purchasing products/services from website) for tracking usage by users of the proprietary information utility for billing purposes.

As concerns claim 2, a proprietary information utility as in claim 1 wherein the second category of proprietary information includes decision support software (website runs off software).

As concerns claim 3, a proprietary information utility as in claim 1 wherein the application services include services to perform at least one of the following activities related to patents: help identify patentable ideas; create patent disclosures; manage pending patents; manage research logs; and, research existing patents (search for books on patents).

As concerns claim 4, a proprietary information utility as in claim 1 wherein the application services include at least one of the services listed below: decision support software; software for troubleshooting products; system configuration services; diagnostic services; planning services; selection services; authoring tools that help authors generate appropriate software models; learning services for data-mining and the ongoing evolution of models; business intelligence services; version management services; presentation services; brokering services; stock selection services; investment portfolio troubleshooting services; investment portfolio selection services; services to troubleshoot devices; medical diagnosis services; services that predict failure and behavior; purchasing decision services; consulting services; skills gap analysis services; translation services for translating decision support models from one underlying technology to another; enterprise resource planning services; and, customer relationship management services (search for books on investment portfolio).

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As concerns claim 5, a proprietary information utility as in claim 1 wherein the first category of proprietary information contains health records and the application services include services to provide services for supporting healthcare and patients, without revealing private information (books on health in a users cart).

As concerns claim 6, a proprietary information utility as in claim 1 wherein the second category of proprietary information includes proprietary information within at least one of the areas listed below: decision support models; and, models associated with troubleshooting products (books on decision support models).

As concerns claim 7, a proprietary information utility as in claim 1 wherein the second category of proprietary information includes decision support models that are based on at least one of the technologies listed below: Bayesian networks; neural networks; case-based systems; model-based systems; rule-based systems; fuzzy systems; decision trees; genetic algorithms; Monte Carlo Markov chains; clustering algorithms; Monte Carlo optimization; simulated annealing; pattern matching; influence diagrams; online analytical processing; collaborative filtering; linear programming; machine learning; and, time series (books on Bayesian networks).

As concerns claim 8, a proprietary information utility as in claim 1 wherein the interfaces allows users to connect to the proprietary information utility using at least one of the following deployment channels: wireless network; cellular phones; internet sites; applications embedded in appliances; applications embedded in devices; applications embedded in vehicle communication and information systems; applications embedded in intelligent agents; and, applications embedded in memory modules (internet sites).

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As concerns claim 9, a proprietary information utility as in claim 1 wherein the application services include services to support the creation, maintenance, and deployment of decision support models, in at least one of the following areas: data-mining; usage reports; business intelligence reports; adaptive learning and refining of models; authoring wizards particular to specific horizontal and vertical industries; and, quality benchmarks of models (books on data-mining).

As concerns claim 10, a proprietary information utility as in claim 1 additionally comprising: an application service registry that manages dynamic registration, access, use, and disposal of the application services (site keeps of items viewed).

As concerns claim 11, a proprietary information utility as in claim 1 additionally comprising: a proprietary information broker that maps semi-structured proprietary information requests to a most appropriate proprietary information model and application services that will operate on the most appropriate proprietary information model (website lists related products to desired products).

As concerns claim 12, a proprietary information utility as in claim 1 wherein the security system provides non-repudiation services in support of billing and reporting (billing information entered on a secure site).

As concerns claim 13, a proprietary information utility as in claim 1 wherein the security system provides privacy for all information transmitted outside of the proprietary information utility, allowing proprietary services to make use of proprietary information utility without revealing anything about users of the proprietary services and without revealing contents of data moving between services (private data is secure not un-secure public data).

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As concerns claim 14, a proprietary information utility as in claim 1 wherein the billing system provides revenue to be generated using at least one of the following pricing schemes: pay-per-use micro-transactions; vendor-visible service-based pricing; hybrid flows; subscription-based pricing; and, price bundling (subscription based pricing for a user ordering a magazine subscription).

As concerns claim 15, a proprietary information utility as in claim 1 additionally comprising: a scaleable computing engine that runs services across many pieces of information (search engine for website).

As concerns claim 16, a proprietary information utility as in claim 1 additionally comprising: a computing engine, the computing engine being used to translate information from an author into a utility-native proprietary information format that can be used by a least a subset of application services within the proprietary information utility (search terms entered into search engine on website).

As concerns claim 17, a proprietary information utility as in claim 1 wherein the billing system calculates royalty payments due to authors when proprietary information of the authors is used by the application services within the proprietary information utility (authors receive royalty payments based on books sold).

As concerns claim 18, a proprietary information utility as in claim 1 additionally comprising an application service registry that manages dynamic registration, access, use, and disposal of the application services, the application service registry providing a service catalog, a discovery mechanism, and a brokering interface that links with the proprietary information broker and the security system to provide a custom view of available application



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services; based on entitlement and visibility (wish list or items in cart or items resulting from a search).

As concerns claim 19, a method comprising the following steps: (a) providing outside entities connection to a proprietary information utility (connect to website); (b) storing proprietary information within a repository, wherein the repository is compartmentalized by user identity and entitlement (memory storing data relating to users, wish list, items ordered); (c) limiting access of each user connecting to the proprietary information utility to proprietary information to which each user is entitled, the proprietary information to which each user is entitled being accessed through use of application services operating within the proprietary information utility (private data, users account), wherein multiple users can be granted access to the same proprietary information (public users may access books and items sold on website, wherein a private user may buy the same products); and, (d) tracking usage of users of the proprietary information utility for billing purposes (users cart on website).

As concerns claim 20, a method as in claim 19 additionally comprising the following step: (e) managing dynamic registration, access, use, and disposal of the application services (user sets up an account).

As concerns claim 21, a method as in claim 19 additionally comprising the following step: (e) mapping semi-structured proprietary information requests to a most appropriate proprietary information model and application services that will operate on the most appropriate proprietary information model (website lists related products to desired products).

As concerns claim 22, a method as in claim 19 wherein step (c) includes providing non-repudiation services in support of billing and reporting (user enters payment info).

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As concerns claim 23, a method as in claim 19 wherein step (c) includes providing privacy for all information transmitted outside of the proprietary information utility, allowing proprietary services to make use of proprietary information utility without revealing anything about users of the proprietary services and without revealing contents of data moving between services (private data transmitted securely, entered on a secure webpage).

As concerns claim 24, a method as in claim 19 wherein step (d) includes providing revenue to be generated using at least one of the following pricing schemes: pay-per-use micro-transactions; vendor-visible service-based pricing; hybrid flows; subscription-based pricing; and, price bundling (subscription based pricing for a user ordering a magazine subscription).

As concerns claim 25, a method as in claim 19 additionally comprising the following step: (e) translating information from an author into a utility-native proprietary information format that can be used by at least a subset of application services within the proprietary information utility (webpage presents text from books in another format for viewing on the webpage).

As concerns claim 26, a method as in claim 26 wherein step (d) includes calculating royalty payments due to authors when proprietary information of the authors is used by the application services within the proprietary information utility (author receives royalty payments based on number of books sold).

As concerns claim 27, a method as in claim 19 additionally comprising the following step: (e) providing a service catalog, a discovery mechanism to provide a custom view of available application services, based on entitlement and visibility (user can search by topic).

***Response to Arguments***

5. Applicant's arguments filed December 12, 2005 have been fully considered but they are not persuasive.

The applicant argues Amazon does not disclose the second category of proprietary information is within domains to which multiple users may be granted use in response to acquiring a license to use particular proprietary information within the second category of proprietary information. The examiner disagrees since "public" data is that which can be accessed by multiple users. The Amazon site can be accessed by a plurality of users, such that multiple users may be granted use. Furthermore Amazon provides a user login ID, which can be interpreted as a license, to use particular proprietary information.

The applicant argues Amazon does not disclose application services. The examiner disagrees since application service provided by Amazon, comprises an application/webpage for searching the webpages for data and information the user requires.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

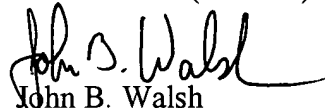
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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Wednesday from 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John B. Walsh  
Primary Examiner  
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